



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/038,004	01/02/2002	Daniel R. Baum	Shutterfly 04C001	8059
31688	7590	06/17/2004	EXAMINER	
TRAN & ASSOCIATES 6768 MEADOW VISTA CT. SAN JOSE, CA 95135			GARG, YOGESH C	
			ART UNIT	PAPER NUMBER
			3625	

DATE MAILED: 06/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/038,004

Applicant(s)

BAUM, DANIEL R.

Examiner

Yogesh C Garg

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|-----------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Amendment D, paper # 15, received on 3/16/2004 is acknowledged and entered. Claim 11 is amended. Currently claims 1-21 are pending for examination. The examiner would like to note that there is a typographical error in claim 11 on page 3, line 17. The term " Previously amended" is to be corrected to --currently amended--- as the limitation " terminated by an order icon" has been added currently.

Response to Arguments

2.1. With reference to the Applicant's submission of a Terminal Disclaimer along with this amendment the T.D is not proper for following reasons:

(i) The TD fee of \$55.00 has not been submitted or an authorization for the use of a deposit account.

(ii) The person who signed the TD is not recognized as an officer of the assignee.

(iii) No documentary evidence of a chain of title from the original inventor (s) to assignee has submitted, nor is the reel and frame number specified as to where such evidence is recorded in the Office (see 37 CFR 3.73(b) and 1140 O.G. 72).

Therefore, the TD is filed in the application file and examiner has maintained the Obviousness --type Double Patenting rejection of claims 1, 3-4, 7-12, 14, 16-17 and 21 over co-pending application number 09/436,704 as presented in the previous office action.

2.2. With reference to the Applicant's amendment of claim 11, the examiner withdraws the objection to claim 11 presented in the previous office action.

2.3. Applicant's arguments filed 3/16/2004 concerning rejection of claims 1-3, 5-12 and 14-21 (see remarks, pages 6-13) under 35 U.S.C. 103(a) as being unpatentable over Shiota in view of

Lockhart and in view of Johnson and further in view of Hartman have been fully considered but they are not persuasive for following reasons:

As requested by the applicant (see remarks, page 7, lines 33-37), the examiner is enclosing a copy of each of the Lockhart provisional applications 60/151,533 filed on August 31, 1999 and 60/159372 filed on October 14, 1999. These applications are listed in USPTO form 892. The examiner has studied these applications and the segment used by the examiner .i.e. page 4 , paragraph 062 is supported by the 60/159372 filed on October 14, 1999 (see at least page 10, line 14-page 11, line 12, page 12, line 23-page 13, line 4).

The applicant argues (see page 006, lines 1-16), " Moreover, Lockhart at best shows a system that emails images using a web interface. Specifically, Lockhart relates to a method for generating and distributing mail items that includes creating a first and a second mail file, Here, Lockhart shows two separate "orders" by first and second users that are then merged into a package for mailing ". In response to applicant's argument that Lockhart shows two separate "orders" by first and second users that are then merged into a package for mailing.....", the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985). Therefore, the applicant's argument is not relevant. What is relevant is the prior art disclosed in Lockhart that is uploading of images directly by a user to be included in the said postcard (see page 4 paragraph 062, " the user is allowed to upload an image using a web interface The user then initiates uploading the image (button 308), and the image data is transferred to mail service computer 110. **Such methods for uploading files are known in the art.** ") in the field of same endeavor as that of Shiota. Shiota also teaches generating postcards online (see col.3, lines col.3, lines 31-46). The PTO can satisfy the burden under section 103 to establish

a prima facie case of obviousness "by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references." See *In re Fine*, 5 USPQ2d 1596 (CA FC 1988). In this case, Lockhart's objective in uploading of images directly by a user is to enable the user to use graphics/photographs of his choice in the postcard and this is done by transferring them directly from any site accessible to the user to the mail service computer 110 for further processing (see at least paragraphs 0050-0054 and 0061-0062 on page 4) for generation of desired postcard. The examiner could rely on these teachings of Lockhart for generation of a desired postcard in Shiota for the same objective of allowing the user to use photographs of his choice in the postcard and transfer those photographs directly from any accessible site to the user to the WWW application server 36. For the reasons given above, the applicant's argument (see remarks, page 6, lines 16-21) that " Lockhart points in the opposite direction to the claimed element of wherein the single card order is completed in a single transaction sequence"., is not persuasive.

The applicant further argues (see remarks, page 9, lines 8-29) that, " The combination of Johnson is improper since Johnson's catalog system is not required in a system that receives "a single card order specifying a plurality of recipients.....Hence, the combination would be inoperative or unnecessary because the customer has the data for the item and is simply placing a single card order specifying a plurality of recipients and, One skilled in the art would not look to Lockhart or Johnson since catalogs are more appropriate with standardized products not produced by the customer". The examiner respectfully disagrees. In response to the applicant's argument, cited above, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references.

Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). In this case, the examiner acknowledged in the previous office action that Shiota in view of Lockhart does not disclose receiving a single order for the plurality of recipients. However, Johnson disclosed that receiving a single order for the plurality of recipients (see at least FIG.16 and col.22, lines 60-62) is a prior art. In view of Johnson, it would have been obvious to a person of an ordinary skill in the art at the time of the applicant's invention to have modified Shiota in view of Lockhart to incorporate the Johnson's teachings of receiving a single order for a plurality of recipients because it will reduce the number of purchaser interactions needed to place orders for different recipients and thereby making it convenient and faster for the user to have the system receive one order for all the recipients. Further, in response to the applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the combined teachings of Shiota in view of Lockhart when combined with Johnson, as per the knowledge generally available to one of ordinary skill in the art will reduce the number of purchaser interactions needed to place orders for different recipients and thereby making it convenient and faster for the user to have the system receive one order for all the recipients.

A prima facie case of obviousness, in view of the above analysis, is established to combine the teachings of Shiota, Lockhart and Johnson.

The applicant further argues (see page 9, line 30-page 13, line 8) that though Hartman shows a single action transaction to terminate the order the combination of Shiota/Johnson/Johnson and Hartman is improper because the teachings of Lockhart and Johnson cannot be combined with Shiota and that a prima facie case of obviousness has not been met because the examiner's rejection fails on at least two of the above requirements that is the references fail to teach all the limitations of the independent claims and that there is no motivation or suggestion either in the cited art references or in the knowledge generally available to one of ordinary skill in the art to modify Shiota reference as to produce the claimed invention. The examiner disagrees. A prima facie case of obviousness, in view of the analysis made above, is already established to combine the teachings of Shiota, Lockhart and Johnson. It has been clearly shown above as well as in the previous office action that Shiota/Johnson/Johnson/ Hartman combined discloses all the limitations of independent claims 1, 14, 17, and 21. The limitations which were not disclosed in Shiota were found as prior art in Hartman/Johnson/Hartman and the examiner has provided the details of the segments from these references to support the claimed limitations in the previous office action. The applicant while arguing the obviousness of combining the references of Lockhart and Johnson (see remarks pages 6-10) has not pointed an error as regards to that these references not disclosing the limitations which examiner found were not disclosed by Shiota. Further, the motivation to combine the teachings of Shiota with Lockhart and the teachings of Shiota in view of Lockhart with Johnson are analyzed above and were present in the previous office action on pages 6-8. The motivation to combine Shiota/Johnson/Johnson with Hartman is also presented in the previous office action on page 8.

In view of the foregoing, the rejection of claims 1- 3, 5-12, and 14-21 is maintained under 35 U.S.C. 103(a) as being unpatentable over Shiota in view of Lockhart and in view of Johnson

and further in view of Hartman, as presented in the previous office action. Since claims 4 and 13 are dependencies of claim 1, their rejections are also maintained. The applicant has not traversed the use of the Tackbary reference and Official Notice in the rejection of claims 4 and 13.

This is a Final office action.

3. Examiner has cited particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that, in preparing responses, the applicant fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 3-4, 7-12, 14, 16-17, and 21 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, 3-5, 8, 9, 10, 15, 35, 38, and 80 of co-pending Application No. 09/436,704. Although the conflicting claims are not identical, they are not patentably distinct from each other because for reasons as given below:

Method claims 1, 16, and 21 of instant application, differ from the method claim 1 of co-pending application No. 09/436,704 that they recite the limitation "card order" in place of "order for image prints" and further specify that the images are uploaded directly by the user. The limitation "order for card" corresponds to the order for image prints only and using a different name "card" in place of "image print" does not patentably distinct each other. Further, adding of the limitation, " images directly uploaded by a user" is an obvious variation of the limitation receiving an order specifying a set of images associated with the recipient as those image have to b supplied by the user and uploading is one of the possible ways. The method claim 16 of the instant application also recites the additional limitation of receiving the order at a " host system" from a "client system" which again are obvious extension of the claim 1 of the co-pending application specifying receiving an order and the order, when being sent via a network, has to be received at a system and that system can be called a host system and the user while sending the order via a network would also use a software browser and the same could be a client system.

Similarly, system claim 14 of instant application is an obvious variation of system claim 80 of the co-pending application No. 09/436,704.

Limitations recited in the dependencies of claim 1, i.e., claims , 3, 4, 7, 8, 9, 10, 11, 12 of instant application are identical to the ones recited in the dependencies of claim 1, i.e. , claims 2, 3-5, 9, 8, 10, 15, 35, and 38 respectively of the co-pending application No. 09/436,704 .

Regarding claim 17 of the instant application, its limitations are already covered by the limitations recited in claims 1 and 4 of the instant application except that it also specifies receiving names and addresses of the recipients to whom the order is to be distributed. Therefore, claim 17 of the instant application is also provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 4 of the co-pending application. As regards the additional limitation of receiving names and addresses, it is obvious variation of the existing limitation of distribution of the cards I claim 1 of the instant application. In order to distribute the cards to recipients it will be obvious to receive their names and addresses.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

5 The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5.1. Claims 1- 3, 5-12, and 14-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shiota in view of Lockhart et al. (US Pub.No: 2002/0103697 A1), hereinafter, referred to as Lockhart and in view of Johnson (US Patent 6,052,670) and further in view of Hartman et al. (US Patent 5,960,411), hereinafter , referred to as Hartman.

Regarding claim 1, Shiota teaches a computer implemented method of distributing cards to a plurality of recipients (see at least abstract), the method comprising:

receiving a card order specifying a plurality of recipients and, for each specified recipient, a set of one or more uploaded images associated with that recipient (col.10, line 33-col.11, line 21 "*.....The WWW application server 36 receives the order file 20 uploaded by the user, selects the laboratory server 8 which is best-suited for processing the order, and transfers the order file 20 as it is or after adding necessary instruction information thereto.....*" . Note, Here, Shiota teaches that the center server receives an order from the customer (personal computer 6) which includes uploaded image data for the prints ordered for recipients. The orders include postcards (col.3, lines 31-35, "*.....the processing number specifying what has been ordered (such as an extra print or a postcard generation).....*") and picture postcards (col.4, lines 28-32, "*.....generation of a picture postcard as described above,.....*") which correspond to a card order in the application. Col.11, line 38-col.12, line 24, "*..... an extra print of a picture a is ordered for the customer while a picture b is for the friend,.....*" discloses that there are plurality of recipients (customer and his/her friend). Also see Fig.1 (6-PC correspond to plurality of recipients);

for each of the plurality of recipients specified in the received card order, printing at least one card having at least one uploaded image from the recipient's image set and distributing the printed cards having the recipients' uploaded images to their respective associated recipients (col.11, lines 38-col.12, line 24. Customer and his friend are the plurality of recipients and prints (which could be photograph/postcards/picture postcards as disclosed in col.3, lines 31-35 and col.4, lines 28-32, "*..... "The printing service" in this specification means not only services*

such as outputting an extra print or generation of a picture postcard as described above, but also all accompanying services carried out before the picture print reaches a customer.....")
with uploaded images are distributed to customer and to the customer's friend).

Shiota does not expressly disclose that the images are directly loaded by a user when generating the card. However, in the field of same endeavor, that is generating a postcard online including image and text to be delivered to recipients, Lockhart discloses uploading of images directly by a user to be included in the said postcard and page 4 paragraph 062, ",
the user is allowed to upload an image using a web interface (e.g., region 302 of the exemplary web page shown in Fig. 3). That is, the user clicks on a "Browse" button 306 to select a graphical image (e.g., a JPG image) that resides on the user system hard drive or network neighborhood. The user then initiates uploading the image (button 308), and the image data is transferred to mail service computer 110. Such methods for uploading files are known in the art.
").

In view of Lockhart, it would have been obvious to a person of an ordinary skill in the art at the time of the applicant's invention to have modified Shiota to incorporate the Lockhart's teachings of uploading images directly by the user because when the desired images are not already available at the image server 15 in Shiota, it will allow the users to upload images directly from another source as explicitly suggested in Lockhart (see at least page 4, paragraphs 0050-0053, "*..Where appropriate (i.e., when the image does not already reside on the mail service computer) the selected image is transferred to mail service computer in step 208 and suitably displayed to the user, e.g., by launching a web browser.... . In general, in the case where the user wishes to create a post card incorporating one or more graphics based on an online, a postcard showcase, or a photo collection, the appropriate graphical elements are stored at any convenient site accessible to the user over network 106. For example, the images*

may be located in a database 111 or other storage medium associated with mail service computer 110. ").

Shiota in view of Lockhart as applied to claim 1 does not expressly disclose receiving a single order for the plurality of recipients. However, in the field of same endeavor of conducting electronic commerce and the analogous art of placing orders online, Johnson discloses receiving a single order for the plurality of recipients (see at least FIG.16 and col.22, lines 60-62, "*Customer has a "contains by value" relationship with the Order class. In other words, each customer may have one or more orders, and each order may have multiple ship addresses and multiple order items*". Note: each order having multiple ship addresses corresponds to receiving order for plurality of recipients in a single transaction). In view of Johnson, it would have been obvious to a person of an ordinary skill in the art at the time of the applicant's invention to have modified Shiota in view of Lockhart as applied to claim 1 to incorporate the Johnson's teachings of receiving a single order for a plurality of recipients because it will reduce the number of purchaser interactions needed to place orders for different recipients and thereby making it convenient and faster for the user to have the system receive one order for all the recipients.

Shiota in view of Lockhart further in view of Johnson as applied to claim 1 does not expressly suggest receiving order in a single transaction sequence. However, in the field of same endeavor of conducting electronic commerce and the analogous art of placing orders online, Hartman discloses receiving an order in a single transaction sequence (see at least col.2, lines 50-57, "*An embodiment of the present invention provides a method and system for ordering an item from a client system.....The client system displays information that identifies the item and displays an indication of an action (e.g., a **single action** such as clicking a mouse button) that a purchaser is to perform to order the identified item.....*". In view of Hartman, it would have been obvious to a person of an ordinary skill in the art at the time of the applicant's

invention to have modified Shiota in view of Lockhart and further in view of Johnson as applied to claim 1 to incorporate the Hartman's teachings of receiving an order in a single transaction sequence because the single transaction sequence ordering system reduces the number of purchaser interactions needed to place an order and reduces the amount of sensitive information that is transmitted between a client system and server system, as explicitly taught in Hartman (see at least col.3, lines 30-37).

Regarding claim 2, Shiota/Lockhart/Johnson/Hartman as applied to claim 1 discloses a computer-implemented method of distributing cards to a plurality of recipients. Shiota further shows that the card is one or more of a greeting card, a post card, and a playing card (see at least col.4, lines 28-32, " *"The printing service" in this specification means not only services such as outputting an extra print or generation of a **picture postcard** as described above, but also all accompanying services carried out before the picture print reaches a customer.* ". Note: Since the claim limitation specifies one or more of a greeting card, a post card..., Shiota by disclosing that the card is a picture postcard satisfies the claimed limitation).

Regarding claim 3, Shiota/Lockhart/Johnson/Hartman as applied to claim 1 discloses a computer-implemented method of distributing cards to a plurality of recipients. Shiota further suggests that the images in a first recipient's image set differ from the images in a second recipient's image set (col.11, lines 38-col.12, line 24, " *an extra print of a picture a is ordered for the customer while a picture b is for the friend,.....* ". Note: picture a is for the customer and picture b is for the friend. Pictures a and b are different pictures which are ordered for two different recipients, that is the customer and his friend).

Regarding claim 5, Shiota/Lockhart/Johnson/Hartman as applied to claim 1 discloses a computer-implemented method of distributing cards to a plurality of recipients. Shiota also teaches that the images are uploaded by a user from a digital camera (see at least col. 2, lines 34-42, “.....a picture image obtained from a memory or the like of a digital camera....”).

Regarding claim 6, Shiota/Lockhart/Johnson/Hartman as applied to claim 1 discloses a computer-implemented method of distributing cards to a plurality of recipients. Shiota also teaches that the images are uploaded by a user to a printing service (see at least , Fig.6. Center Server is the printing service. Also see col.10, line 30-col.11, line 21 and col.1, line 56-col.2, line 10),

Regarding claim 7, Shiota/Lockhart/Johnson/Hartman as applied to claim 1 discloses a computer-implemented method of distributing cards to a plurality of recipients. Shiota also teaches that receiving, printing and distributing is dispersed among two or more different entities (at least see, Fig.6. Center Server is the printing service. Also see col.10, line 30-col.11, line 21 and col.1, line 56-col.2, line 10. Note: laboratory server and center server are two or different entities).

Regarding claim 8, Shiota/Lockhart/Johnson/Hartman as applied to claim 1 discloses a computer-implemented method of distributing cards to a plurality of recipients. Shiota also teaches that the steps of receiving, printing and distributing is performed by a single entity (col.1, lines 29-38, “..However, it is preferable to have only one wholesale labdata management “. Note: To have only one wholesale lab to manage all data concerning receiving

the orders corresponds to having a single entity to perform all the steps of receiving, printing and distributing.).

Regarding claim 9, Shiota/Lockhart/Johnson/Hartman as applied to claim 1 discloses a computer-implemented method of distributing cards to a plurality of recipients. Shiota also teaches that receiving a card order is performed by an enterprise providing a web front-end (See. Figs.1 and 6." "Center server 12 " which is a www application server and receives the orders from the customer's personal computers corresponds to an enterprise providing a web front-end. Also see col.10, lines 30-41).

Regarding claim10, Shiota/Lockhart/Johnson/Hartman as applied to claim 1 discloses a computer-implemented method of distributing cards to a plurality of recipients. Shiota also teaches that prior to printing, dividing the received card order into a plurality of sub-card orders, each sub-card order corresponding to a different recipient (col.11, lines 38-col.12, line 24. Note: picture a is for the customer and picture b is for the friend. Pictures a and b could be different which are ordered for two different recipients, that is the customer and his friend and in order to process them they will inherently be sub divided into separate sub-cards belonging to the customer and friend respectively.).

Regarding claims 11 and 12, the limitation that the card order comprises a single transaction sequence is already covered and analyzed in claim 1.

Shiota/Lockhart/Johnson/Hartman as applied to claim 1 discloses a computer-implemented method of distributing cards to a plurality of recipients and receiving an order in a single transaction sequence. Shiota/Lockhart/Johnson/Hartman as applied to claim 1 does not

suggest that the single transaction sequence is terminated by a click of a "card order" button/order icon. However, in the field of same endeavor of conducting electronic commerce and the analogous art of placing orders online, Hartman discloses that the single transaction sequence is terminated by a click of an order icon or a "card order" button. (see at least col.2, lines 50-57, " *An embodiment of the present invention provides a method and system for ordering an item from a client system.....The client system displays information that identifies the item and displays an indication of an action (e.g., a single action such as clicking a mouse button) that a purchaser is to perform to order the identified item.....* ". Note: In Hartman, *a single action such as clicking a mouse button* ' corresponds to a click of "card order" button or an order icon as claimed.). In view of Hartman, it would have been obvious to a person of an ordinary skill in the art at the time of the applicant's invention to have modified Shiota/Lockhart/Johnson/Hartman as applied to claim 1 to incorporate the Hartman's teachings of terminating the single transaction sequence by a click of an order icon or a "card order" button because such ordering system reduces the number of purchaser interactions needed to place an order and reduces the amount of sensitive information that is transmitted between a client system and server system, as explicitly taught in Hartman (see at least col.3, lines 30-37).

Regarding system claim 14, all the functional limitations are already covered in the method steps of claims 1 and 9 and are therefore analyzed and rejected on the basis of same rationale, see above, as unpatentable over Shiota/Lockhart/Johnson/Hartman. As regards, the structural elements, see Shiota, (at least FIG.6, where "12" Central server, which receives the order from the client system, corresponds to the front-end computer sub-system and the Laboratory server "8" corresponds to the distribution sub-system.).

Regarding claim 15, Shiota/Lockhart/Johnson/Hartman as applied to claim 14 discloses a computer-implemented system of distributing cards to a plurality of recipients. Further, the recited limitation in claim 15 is already covered and analyzed in claim 2 above and is therefore rejected based on same rationale as unpatentable over Shiota/Lockhart/Johnson/Hartman.

Regarding method claim 16, all the limitations are already covered in the method steps of claims 1 and 9 and are therefore analyzed and rejected on the basis of same rationale, see above, as unpatentable over Shiota/Lockhart/Johnson/Hartman. As regards the host system and client system, see Shiota, (at least FIG.6, where "12" Central server, which receives the order from the client system, corresponds to the host system and the WWW Browser on customer's personal computer "6" corresponds to the client-system.).

Regarding method claim 17, all the limitations are already covered in the method steps of claims 1 and 4 and are therefore analyzed and rejected on the basis of same rationale, see above, as unpatentable over Shiota/Lockhart/Johnson/Hartman. As regards the limitation of obtaining address information including names and addresses of one or more recipients, they are inherently needed to distribute the cards to the recipients.

Regarding method claims 18 and 19, all the recited limitations are already covered in the method steps of claims 5 and 6 and are therefore analyzed and rejected on the basis of same rationale, see above, as unpatentable over Shiota/Lockhart/Johnson/Hartman.

Regarding claim 20, Shiota/Lockhart/Johnson/Hartman as applied to claim 1 discloses a computer-implemented method of distributing cards to a plurality of recipients and the images

are directly uploaded by the user. Shiota/Lockhart/Johnson/Hartman as applied to claim 1 does not suggest that the images are uploaded by a user from a data storage device. However, in the field of same endeavor, that is generating a postcard online including image and text to be delivered to recipients, Lockhart discloses uploading of images directly by a user from a data storage device (see at least page 4 paragraph 0053, " *In general, in the case where the user wishes to create a post card incorporating one or more graphics based on an online, a postcard showcase, or a photo collection, the appropriate graphical elements are stored at any convenient site accessible to the user over network 106. **For example, the images may be located in a database 111 or other storage medium associated with mail service computer 110. Alternatively, the graphics may be distributed over a number of databases or vendors accessible over network 106*** "). In view of Lockhart, it would have been obvious to a person of an ordinary skill in the art at the time of the applicant's invention to have modified Shiota/Lockhart/Johnson/Hartman as applied to claim 1 above to incorporate the Lockhart's teachings of uploading images directly by the user from a data storage device because when the desired images are not already available at the image server 15 in Shiota, it will allow the users to upload images directly from another source/database as explicitly suggested in Lockhart (see at least page 4 paragraph 0050, "*Where appropriate (i.e., when the image does not already reside on the mail service computer) the selected image is transferred to mail service computer in step 208 and suitably displayed to the user, e.g., by launching a web browser....* ").

Regarding claim 21, all the method steps of the claim, except one, are already covered in the method steps of claim 1 above. The step, that the order is received from the orderer and that at least one of the specified recipients is different from the orderer is not covered in claim 1

above. However, Shiota does teach this limitation that the order is received from the orderer and that at least one of the specified recipients is different from the orderer (see at least col.11, lines 54-61, "*After the customer returns, he/she accesses the center server 12 from the personal computer 6 at home and orders extra prints of these pictures (105). At this time,an extra print of a picture a is ordered for the customer while a picture b is for the friend,*". Note: Here, in Shiota the orderer is a customer and one of the recipients is a friend of a customer who is different from the orderer.). Therefore, claim 17 is also rejected as being unpatentable over Shiota in view of Lockhart further in view of Johnson and further in view of Hartman.

5.2. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shiota/Lockhart/Johnson/Hartman and further in view of Tackbary et al. (US Patent 6,092,054).

Regarding claim 4, Shiota/Lockhart/Johnson/Hartman teaches a computer-implemented method of distributing cards to a plurality of recipients, as disclosed and analyzed in claim 1 above. Shiota also teaches that print parameters of a first recipient's cards differ from printing parameters of a second recipient's cards (see at least col. Col.11, lines 54-61, "(see at least col.11, lines 54-61, "*After the customer returns, he/she accesses the center server 12 from the personal computer 6 at home and orders extra prints of these pictures (105). At this time,an extra print of a picture a is ordered for the customer while a picture b is for the friend,*". Note: Here, in Shiota the prints ordered for the orderer is a and for the 2nd recipient, who is a friend, is b. The prints a and b are different and hence the printing matter of a and b will be different .). Shiota further shows that the print parameters include one or more of print size, number of copies, print finish (col.3, lines 31-35, "*The order information" specifically means, for example, the processing number specifying what has been ordered (such as an extra print or a*

postcard generation), the image number identifying a picture, the size of the print, and the number of the print...". Also see col.8, lines 31-36. Note: " requirement of extra prints" correspond to the number of copies as claimed. Since the claim limitation specifies one or more of print size, number of copies, ..., Shiota by disclosing that the card order information includes print size, number of extra prints satisfies the claimed limitation).,

Shiota/Lockhart/Johnson/Hartman as applied to claim 1 does not disclose that the print parameters include a textual message. However, in the field of same endeavor, Tackbary teaches printing a greeting card and a playing card with textual message which are grouped under "social expression cards " (at least see, col.1, line 19-col.2, line 46, "*....The invention relates... ordering, and delivering social expression cards.....upon receiving an order, to select designated cards....print the buyer's messages on the cards, and send the cards to the buyer or the recipients*".). In view of Tackbary, it would have been obvious to a person of an ordinary skill in the art at the time of the invention to modify Shiota/Lockhart/Johnson/Hartman to include the feature of printing and distributing greeting card, playing card or other social expression cards such as picture postcard with textual message. Doing so would allow the customer in Shiota to modify the picture postcards to social expression cards, like greeting cards or playing cards, with textual messages and send them on occasions like birthdays/anniversary, etc. and thereby eliminating the need to spend time and effort in buying them from another source.

5.3. Claim 13 is rejected under 35 U.S.C. 103(a) as being obvious over Shiota/Lockhart/Johnson/Hartman in view of an Official Notice.

Regarding claim 13, Shiota/Lockhart/Johnson/Hartman teaches a computer-implemented method of distributing cards to a plurality of recipients, as disclosed and analyzed in claim 1 above. Shiota further discloses that customer, while transmitting order information to the central server 12, also transmits information on “ payment method” (see at least (Fig.2) and col.8, lines 31-46). Shiota does not expressly disclose that the payment method is one or more of a credit card, a debit card, electronic funds transfer, a gift certificate, or a coupon. However, Official Notice is taken of both the concept and benefits of making payment online by one or more of the old and well-known methods such as credit card, a debit card, electronic funds transfer, a gift certificate, or a coupon for the obvious reasons of convenience to both the customers and merchants and closing the purchase or sale transaction. In view of the Official Notice, it would have been obvious to a person of an ordinary skill in the art at the time of the invention to use one or more of the very old and well-known payment methods such as credit card, a debit card, electronic funds transfer, a gift certificate, or a coupon. Doing so makes it convenient for both the customers and merchants to close the purchase or sale transaction without waiting to pay by cash.

Conclusion

6 **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

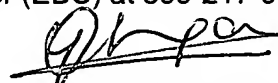
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yogesh C Garg whose telephone number is 703-306-0252. The examiner can normally be reached on M-F(8:30-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent A Millin can be reached on 703-308-1065. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Yogesh C Garg
Primary Examiner
Art Unit 3625

YCG
June 10, 2004